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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,525	11/24/2003	Hiroharu Inoue	P24616	1953
7055	7590	10/11/2007		EXAMINER
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				CHEVALIER, ALICIA ANN
			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			10/11/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/718,525	INOUE ET AL.
	Examiner Alicia Chevalier	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 7/09/07.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
  - 4a) Of the above claim(s) 1,19 and 20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-18,21 and 22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

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#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **RESPONSE TO AMENDMENT**

1. Claims 1-22 are pending in the application, claims 1, 19 and 20 are withdrawn from consideration.

### ***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. §112, first paragraph, rejections of claims 2-18, 21 and 22, made of record in the office action mailed March 9, 2007, pages 2-3, paragraph #5 have been withdrawn due to Applicant's arguments in the response filed July 9, 2007.

### ***REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 103***

4. Claims 2-18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchida et al. (U.S. Patent No. 6,835,241) in view of Yeager et al. (U.S. Patent No. 6,352,782).

Tsuchida discloses a laminate sheet comprising a polyphenylene ether sheet (*col. 6, line 20*) and a copper foil (*title*). The foil has a surface roughness of 2  $\mu$ m or less (*col. 3, lines 13-15*) and the surface thereof facing the sheet with zinc or a zinc alloy (*col. 6, lines 3-5*) and at the same time coupled with a silane coupling agent having a vinyl group (*col. 5, lines 14-16*).

Tsuchida fails to disclose the claims polyphenylene ether composition.

Yeager teaches the claimed meta or para polyphenylene ether composition (*summary of the invention*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Yeager's polyphenylene composition as Tsuchida's composition in order to insulation propoerites and make the composition fire restraint (*Yeager, abstract*). Furthermore, it has been held that finding the members of a class of prior art polymers which are best suited for a particular propose is not patentable invention. *Ex parte Fauser* (POBA 1953) 128 USPQ 156. Given the board range of polymers encompassed by meta or para polyphenylene it would have been obvious for one of ordinary skill in the art to fin the best orientation of polyphenylene to use in the prepeg.

The limitation "piling a prepeg" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

5. Applicant's arguments in the response filed July 9, 2007 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490.

The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac  
10/1/07

  
ALICIA CHEVALIER  
PRIMARY EXAMINER